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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,578	12/11/2003	Adam James Smith	FBU-001	2559
959 7590 02/11/2008 LAHIVE & COCKFIELD, LLP ONE POST OFFICE SQUARE BOSTON, MA 02109-2127			EXAMINER MUSA, ABDELNABI O	
			ART UNIT 2146	PAPER NUMBER
			MAIL DATE 02/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/735,578

**Applicant(s)**

SMITH, ADAM JAMES

**Examiner**

Abdelnabi O. Musa

**Art Unit**

2146

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,8,11,23-29 and 31-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8,11,23-29 and 31-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Acknowledgment is made for the applicant's response and amendment filed on 11/27/2007.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-3, 8, 11, 23-29, and 31-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama et al. Pub. No.: (US-2002/0194264 A1) as applied to claim 1 above, and further in view of Gold et al Pub. No.: (US 2002/0032752 A1)

As per **claim 1**, Uchiyama teaches a system for playing audio and/or video tracks in a public place in response to requests made by people (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1), in which a jukebox apparatus is situated in the public place (jukebox provide a plurality of audio and video to the general public [0027]), the jukebox apparatus providing a plurality of audio and/or video tracks stored on the jukebox apparatus (a digital information server which stores digital information to be

distributed [0014] [0015] [0056]) from which a selection of tracks to be played in the public place can be made by people in the public place (jukebox provide a plurality of audio and video to the general public [0027]), the jukebox apparatus being adapted to register requests for tracks to be played and to store requests whilst other requested tracks are played (a user would be able to request songs digitally [0012]; [0014]; [0017]), wherein the jukebox apparatus registers a request in response to a text message transmitted by a person using a mobile communications device (the system is automatically registers and responds to the owner of the telecommunication device, [Abstract]; [0054]; FIG. 2) which is adapted to transmit text messages over a wireless communications network (a user can request music and videos using a telecommunication device and a wireless connection [0016]; [0029]; FIG. 6), the text message comprising

(i) an identification code for a track which has been input by the person (the user makes a music selection using the numbers or letters on the keypad that correspond to the desired music through an operation created with the keypad [0029]; [0032]; FIGs. 3-5) and

(ii) associated alphanumeric text which has been input by the person (the selection associated by using numbers or letters on the keypad corresponding to the desired music through an operation created with the keypad [0029]; [0032]) and which the person wishes to be displayed as a message at the public place (jukebox provide a plurality of audio and video to the general public [0027]) in association with playing of the track; the text message is received by the jukebox apparatus and scanned

automatically to identify the identification code for the track and the associated alphanumeric text (the user makes a music selection using the numbers or letters on the keypad that correspond to the desired music through an operation created with the keypad [0029]; [0032]; FIGs. 3-5), the identified code is automatically authenticated and processed to provide data instructions which register the request for the track (the system is automatically registers and responds to the owner of the telecommunication device, [Abstract]; [0054]; FIG. 2); the requested track is played in the public place by the jukebox apparatus (jukebox provide a plurality of audio and video to the general public [0027]), and the associated alphanumeric text is displayed on a display unit in the public place (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1) in association with playing of the requested track (requesting and displaying digital information including music video clips and interactive game [0027] [0031] [0059])

Uchiyama does not teach the specifics on transmitting the information between the jukebox and the requester includes sending messages and text input such as a greetings to be displayed along with the track on the display screen at the site, and a confirmation text message sent back to the mobile communications device for the user to know that the request has been received and further does not teach the specifics on the text message containing the code for the selected product or service. However, Gold teaches a text message is sent to the electronic song detection "jukebox" from the mobile communication device with the code of the requested track, and a return text message or an email or even a voice message is sent back to the user confirming the

reception of the request ([0031] [0032] [0064] [0066]) wherein the request is in the form of a webpage containing data files for the user input of song search criteria and the keyboard controller is operable for the user to input of command to the song dedication server ([0036] [0068])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Gold et al. a mobile communication device is any device that can remotely communicate with the jukebox server on the network, sending a text message or an email as a request for a song to be played or a text to be displayed on the screen would return the same result. Also, one would consider having the option inputting text to search for songs instead of given the option of selecting text only to request songs. The user has to have some kind of confirmation of whether the request has been successfully submitted or not.

As per **claim 2**, Uchiyama teaches a system as claimed in claim 1, wherein the wireless communications network is a mobile telephone network (a mobile telephone network is used for communication [0027]; [0038])

As per **claim 3**, Uchiyama teaches a system as claimed in claim 2, wherein the mobile communications device is a mobile telephone(a mobile telephone network is used for communication [0027]; [0038]) but does not teach wherein the text message is a Short Message Service (SMS) text message. However, Gold teaches a text message

is sent to the electronic song detection "jukebox" from the mobile communication device ([0031] [0032] [0064] [0066])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Gold et al. the mobile communication device would be capable of sending the request in the form of text message

Claims 4-6. (**Canceled**)

As per **claim 8**, Uchiyama teaches a system as claimed in claim 1, wherein when the request for the track has been received, a confirmation text message is transmitted over the wireless communications network to the mobile communications device of the person making the request (a confirmation is send to the user once the request is achieved [0054]; [0056]; [0058]) but Uchiyama does not teach the specifics on the type of confirmation as the confirmation being is a text message sent back to the user. However, Gold teaches a text message is sent to the electronic song detection "jukebox" from the mobile communication device with the code of the requested track, and a return text message or an email or even a voice message is sent back to the user confirming the reception of the request ([0031] [0032] [0064] [0066])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Gold

et al. a text message would be considered as a confirmation for a request in a mobile communication device.

**Claims 9-10. (Canceled)**

As per **claim 11**, Uchiyama teaches a system as claimed in claim 8 wherein the wireless communications network is a mobile telephone network (a mobile telephone network is used for communication [0027]; [0038]), the wireless communications device is a mobile telephone(a mobile telephone network is used for communication [0027]; [0038]), but does not teach the text message comprising the identification code for the track and the associated alphanumeric text is a Short Message Service (SMS) text message, and the confirmation message is transmitted as a Short Message Service (SMS) text message over the mobile telephone network. However, Gold teaches a text message is sent to the electronic song detection "jukebox" from the mobile communication device with the code of the requested track, and a return text message or an email or even a voice message is sent back to the user confirming the reception of the request ([0031] [0032] [0064] [0066])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Gold et al. a text message would be considered as a confirmation for a request in a mobile communication device.



Claims 12-22. (**Canceled**)

As per **claim 23**, Uchiyama teaches a system for supplying a product or service to a user from a provider (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1), selected from a range of products or services available from the provider (the user makes a music selection using the numbers or letters on the keypad that correspond to the desired music through an operation created with the keypad [0029]; [0032]; FIGs. 3-5), each product or service having an associated alphanumeric code (songs are identified by their bar codes for the user to be selected and displayed [0041]; [0049]; [0050]; [0052]; [0056]), wherein the user has a portable communications device adapted for voice and text message communication over a public mobile telephone network (a mobile telephone network is used for communication [0027]; [0038]) but does not teach the specifics where the provider has data processing means which is connected to the public mobile telephone network so as to receive text messages addressed to a provider's telephone number on the network, the user operates the portable communications device to transmit over the network to the provider's telephone number a text message containing the alphanumeric code of a selected product or service, the user's text message is received by the data processing means together with the telephone number of the user's portable communications device, the received text message is analysed by the data processing means to determine the code of the product or service selected by the user, supply of the product or service associated with

the code is initiated automatically by the data processing means, and the data processing means automatically transmits a confirmatory text message to the user's portable communications device over the network. However, Gold teaches a text message is sent to the electronic song detection "jukebox" from the mobile communication device with the code of the requested track, and a return text message or an email or even a voice message is sent back to the user confirming the reception of the request ([0031] [0032] [0064] [0066]) wherein the request is in the form of a webpage containing data files for the user input of song search criteria and the keyboard controller is operable for the user to input of command to the song dedication server ([0036] [0068])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Gold et al. a mobile communication device is any device that can remotely communicate with the jukebox server on the network, sending a text message or an email as a request for a song to be played or a text to be displayed on the screen would return the same result. Also, one would consider having the option inputting text to search for songs instead of given the option of selecting text only to request songs. The user has to have some kind of confirmation of whether the request has been successfully submitted or not.

As per **claim 24**, Uchiyama teaches a system as claimed in claim 23, wherein the product or service is an audio and/or video track to be played to the user in a public

place by jukebox apparatus (a system for displaying remotely digital contents such as music and video data using a telecommunication device [0004]; [0010] which's a jukebox that provide a plurality of audio and video to the general public [0027])

As per **claim 25**, Uchiyama teaches a system for playing audio and/or video tracks in a public place in response to requests made by people (a system for displaying remotely digital contents such as music and video data using a telecommunication device, [Abstract]; [0004]; [0010]; FIG. 1), in which a jukebox apparatus is situated in the public place (jukebox provide a plurality of audio and video to the general public [0027]), the jukebox apparatus providing a plurality of audio and/or video tracks from which a selection of tracks to be played (a user would be able to request songs digitally [0012]; [0014]; [0017]) in the public place can be made by people in the public place(jukebox provide a plurality of audio and video to the general public [0027]), the jukebox apparatus being adapted to register requests for tracks to be played and to store requests whilst other requested tracks are played ]) (a digital information server which stores digital information to be distributed [0014] [0015] [0056]), wherein a text message is transmitted by a person using a mobile communications device (the system is automatically registers and responds to the owner of the telecommunication device, [Abstract]; [0054]; FIG. 2) which is adapted to transmit text messages over a wireless communications network (a user can request music and videos using a telecommunication device and a wireless connection [0016]; [0029]; FIG. 6), the text message comprising an identification code for a track which has been input by the

person (the user makes a music selection using the numbers or letters on the keypad that correspond to the desired music through an operation created with the keypad [0029]; [0032]; FIGs. 3-5); the text message is received and scanned automatically to identify the identification code for the track, the identified code is automatically authenticated and processed to provide data instructions which register the request for the track in the jukebox apparatus (the system is automatically registers and responds to the owner of the telecommunication device, [Abstract]; [0054]; FIG. 2); a confirmation text message is transmitted over the wireless communications network to the mobile communications device of the person making the request; and the requested track is played in the public place by the jukebox apparatus (requesting and displaying digital information including music video clips and interactive game [0027] [0031] [0059])

Uchiyama does not teach the specifics on transmitting the information between the jukebox and the requester includes sending messages and text input such as a greetings to be displayed along with the track on the display screen at the site, and a confirmation text message sent back to the mobile communications device for the user to know that the request has been received and further does not teach the specifics on the text message containing the code for the selected product or service. However, Gold teaches a text message is sent to the electronic song detection "jukebox" from the mobile communication device with the code of the requested track, and a return text message or an email or even a voice message is sent back to the user confirming the reception of the request ([0031] [0032] [0064] [0066]) wherein the request is in the form of a webpage containing data files for the user input of song search criteria and the

keyboard controller is operable for the user to input of command to the song dedication server ([0036] [0068])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Gold et al. a mobile communication device is any device that can remotely communicate with the jukebox server on the network, sending a text message or an email as a request for a song to be played or a text to be displayed on the screen would return the same result. Also, one would consider having the option inputting text to search for songs instead of given the option of selecting text only to request songs. The user has to have some kind of confirmation of whether the request has been successfully submitted or not.

As per **claim 26**, Uchiyama teaches a system as claimed in claim 25, wherein the wireless communications network is a mobile telephone network (a mobile telephone network is used for communication [0027]; [0038])

As per **claim 27**, Uchiyama teaches a system as claimed in claim 26, wherein the wireless communications device is a mobile telephone (a mobile telephone network is used for communication [0027]; [0038])

As per **claim 28**, Uchiyama teaches a system as claimed in claim 27 but does not teach wherein the text message comprising the identification code for the track and

the confirmation message are Short Message Service (SMS) text messages transmitted over the mobile telephone network. However, Gold teaches a text message is sent to the electronic song detection "jukebox" from the mobile communication device with the code of the requested track, and a return text message or an email or even a voice message is sent back to the user confirming the reception of the request ([0031] [0032] [0064] [0066])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Gold et al. a text message would be considered as a confirmation for a request in a mobile communication device.

As per **claim 29**, Uchiyama teaches a system as claimed in claim 25 wherein prior to the user transmitting the text message containing the identification code for the track (identification code is sent with the message or prompted to the user to enter an identity for songs [0056] [0052]) but does not teach the user transmits a search text message containing search criteria in order to obtain information about available tracks, the search text message is received, a search is conducted for available tracks on the jukebox apparatus in accordance with the search criteria, and a search result text message is transmitted to the user's mobile telephone, the search result text message containing the names and associated codes of available tracks corresponding to the search criteria. However, Gold teaches upon entering the search criteria, the sender receives a list of available songs meeting the criteria then the

sender may then select a song from the list and continue the process and complete a dedication ([0007] [0017] [0031])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Gold et al. sending a text message or an email as a request for a song to be played or a text to be displayed on the screen would return the same result. Also, one would consider having the option inputting text to search criteria for songs and having some kind of confirmation of whether the request has been successfully submitted.

3. Claim 7 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama et al. Pub. No.: (US-2002/0194264 A1) as applied to claim 1 above, and further in view of Newnam et al Pub. No.: (US-2002/0133562 A1)

As per **claim 7**, Uchiyama teaches a system as claimed in claim 1 but does not teach including a filter for offensive language in the associated alphanumeric text. However, Newnam teaches filtering items and filter certain language including a filter for offensive language (refer to [0031]).

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Newnam. One would consider the use of filtering when processing information especially when such information received over a mobile communication. A filter is used to sort data to transmit clean messages to the server to comply with requests.

As per **claim 30**, Uchiyama teaches a system as claimed in claim 2, wherein the wireless communications device is a mobile telephone (a mobile telephone network is used for communication [0027]; [0038]), and transmission of the message with the identification code for the track (identification code is sent with the message or prompted to the user to enter an identity for songs [0056] [0052]) but does not teach associated alphanumeric text is by means of Wireless Application Protocol (WAP) over the mobile telephone network. However, Newnam teaches interactive programming that are available on handheld devices including Wireless Application protocol "WAP" [0004] [0010])

It would have been obvious to a person having ordinary skilled in the art at the time the invention was made to have modified Uchiyama et al, by the teaching of Newnam. Internet devices and mobile communication devices prompt users to associate alphanumeric text in their request including Wireless Application Protocol (WAP) over the mobile telephone network.

Claims 31-43 are related to the same limitation set for hereinabove, where the difference used is the order of the wordings of the claims that were interchanged within the claim itself and was differently presented from the above treated claims. This change does NOT effect the limitation of the above treated claims. The citations from the prior art have been inserted as needed. Even though claims 31-43 have been differently written from the above treated claims, yet, the limitations did NOT change. As mentioned, claim 31 is the same as claim 29, claim 32 and 40 are the same as claim 8,



claim 33 is the same as claim 11, claim 34 and 41 are the same as claim 1, claim 35 is the same as claim 2, claim 36 and 43 are the same as claim 3, claim 37 and 38 are the same as claim 11, claim 39 is the same as claim 1, claim 42 is the same as claim 30, again there is no difference in ***limitations*** between claims 31-43 and the above treated claims, Refer to **MPEP** on claim format and presentations

### **Conclusion**

4. Applicant's arguments with respect to the above presented claims have been considered but are moot in view of the new ground(s) of rejection.

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action

When responding to this office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdelnabi O. Musa whose telephone number is 571-2701901. The examiner can normally be reached on Monday thru Friday: 7:30am to 5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on 571-2726798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.M

  
JEFFREY PWU  
SUPERVISORY PATENT EXAMINER